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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,074	02/06/2007	Manuel Gonzalez	200310853-3	2398

22879 7590 09/02/2009  
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EXAMINER
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PACHOL, NICHOLAS C

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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09/02/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/571,074	<b>Applicant(s)</b> GONZALEZ, MANUEL	
	<b>Examiner</b> Nicholas C. Pachol	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/06/07</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18 and 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Regarding claims 18 and 20, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 35 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 35 claims "A computer program which is arranged to: ..." However, the claims do not define a program to be a functional descriptive material encoded on a memory/disk/computer-readable medium, and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function

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of the descriptive material to be realized”). Moreover, a “program” is neither a process (“action”), nor machine, nor manufacture, nor composition of matter (i.e., tangible “thing”) and therefore non-statutory.

Such claimed “program” (software) does not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program’s functionality to be realized. As such, “program”/software, not claimed as embodied/encoded in computer-readable medium and is not statutory because the “program”/software is not capable of causing functional change in the computer. Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory and appears to be one type of claim that is considered nonstatutory, under the present USPTO Interim Guidelines, 1300 Official Gazette Patent and Trademark Office 142 (Nov. 22, 2005).

5. Claims 16-25 appear to be proper in regards to 25 USC 101. By having a digital document, some type of computer must be used in order to perform the printing since a digital document is known to be on a computer. Therefore the claims are tied to an apparatus.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 16, 17, and 21-35 rejected under 35 U.S.C. 102(e) as being anticipated by Silverbrook (US 6,987,573).

Regarding Claim 16, Silverbrook teaches a method of printing a digital document (Column 1, lines 5-13) comprising:

providing a first document for printing, the first document comprising at least one functional area in which pattern markings are to be printed (Column 2, lines 3-5 and Column 4, line 66 - Column 5, line 6, wherein the document is prepared to be printed with the content and the coded data),

generating from the first document a second document in which at least one of the shape and or size and or location of the at least one functional area is modified, obtaining a portion of pattern to fit the modified functional area (Figure 25, elements 836, 834 and Column 12, lines 10-42, wherein the first document is the original document and the second document is the formatted document. The formatted document is adjusted from the original document to print the document as desired by the user in regards to the user's preferences, i.e. size.); and

printing the second document (Column 14, lines 15-17).

Regarding Claim 17, Silverbrook further teaches in which the first document includes some content (Column 12, lines 12-17, wherein the text and image objects are content).

Regarding Claim 21, Silverbrook further teaches in which the step of obtaining the pattern for the functional area includes a step of requesting a portion of pattern for the functional area from a pattern allocation device (Column 12, lines 28-42, wherein by allocating the a different size, the pattern is then adjusted within the spatial extent or zone to be able to be properly formatted on the page).

Regarding Claim 22, Silverbrook further teaches in which the amount of pattern requested and the identity of the pattern (its location in pattern space) is determined according to the size of the modified functional area (Column 12, lines 28-42, wherein by allocating the a different size, the pattern is then adjusted within the spatial extent or zone to be able to be properly formatted on the page).

Regarding Claim 23, Silverbrook further teaches in which the step of requesting pattern comprises requesting an area of pattern larger than that which is required for a functional area of a document and allocating a sub-portion to the functional area according to how it has been modified (Column 12, lines 28-42, wherein by allocating the a different size, the pattern is then adjusted within the spatial extent or zone to be able to be properly formatted on the page).

Regarding Claim 24, Silverbrook further teaches in which the step of requesting pattern comprises requesting an area of pattern larger than that which is required for a functional area of a document and allocating a sub-portion to the functional area according to how it has been modified (Column 12, lines 28-42, wherein by allocating the a different size, the pattern is then adjusted within the spatial extent or zone to be able to be properly formatted on the page).

Regarding Claim 25, Silverbrook further teaches in which the step of modifying the functional area comprises increasing its size, varying its aspect ratio or rotating the area relative to the remainder of the document (Column 12, lines 28-42).

Regarding Claim 26, Silverbrook teaches a digital document printing apparatus (Column 1, lines 5-13) comprising:

- a print application which receives a first document for printing, the first document comprising at least one functional area in which pattern markings are to be printed (Column 2, lines 3-5 and Column 4, line 66 - Column 5, line 6, wherein the document is prepared to be printed with the content and the coded data),

- a document generating means arranged to generate from the first document a second document in which at least one of the shape and or size and or location of the at least one functional area is modified (Figure 25, elements 836, 834 and Column 12, lines 10-42, wherein the first document is the original document and the second

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document is the formatted document. The formatted document is adjusted from the original document to print the document as desired by the user in regards to the user's preferences, i.e. size.), and

a pattern allocation unit which is arranged to allocate a portion of pattern to fit the modified functional area at the request of the print application in which the print application allocates pattern to the functional area according to its shape and or location and or size after modification (Column 14, lines 15-17).

Regarding Claim 27, Silverbrook further teaches in which the print application is arranged to generate a print file which comprises a set of instructions in a language which can be understood by a printing device (Column 14, lines 15-17 and Column 47, lines 55-67)

Regarding Claim 28, Silverbrook further teaches which includes a printer which is adapted to print the second document together with the pattern markings (Column 14, lines 15-17).

Regarding Claim 29, Silverbrook further teaches in which the pattern allocation unit allocates a portion of pattern that is larger than the required and the print application allocates a sub- portion of this portion to the functional space (Column 12, lines 28-42, wherein by allocating the a different size, the pattern is then adjusted within the spatial extent or zone to be able to be properly formatted on the page).



Regarding Claim 30, Silverbrook further teaches in which the pattern allocation unit allocates a portion of pattern that is larger than the required and the print application allocates a sub- portion of this portion to the functional space (Column 12, lines 28-42, wherein by allocating the a different size, the pattern is then adjusted within the spatial extent or zone to be able to be properly formatted on the page).

Regarding Claim 31, Silverbrook further teaches in which the pattern allocation unit stores a set of identifiers which uniquely identifies each of a set of first documents and allocates a unique portion of pattern to each document (Column 12, lines 28-42, wherein by allocating the a different size, the pattern is then adjusted within the spatial extent or zone to be able to be properly formatted on the page).

Regarding Claim 32, Silverbrook further teaches in which the pattern allocation unit stores a set of identifiers which uniquely identifies each of a set of first documents and allocates a unique portion of pattern to each document (Column 12, lines 28-42, wherein by allocating the a different size, the pattern is then adjusted within the spatial extent or zone to be able to be properly formatted on the page).

Regarding Claim 33, Silverbrook further teaches in which the pattern allocation unit stores a set of identifiers which uniquely identifies each of a set of first documents and allocates a unique portion of pattern to each document (Column 12, lines 28-42,

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wherein by allocating the a different size, the pattern is then adjusted within the spatial extent or zone to be able to be properly formatted on the page).

Regarding Claim 34, Silverbrook further teaches in which the pattern allocation unit stores a set of identifiers which uniquely identifies each of a set of first documents and allocates a unique portion of pattern to each document (Column 12, lines 28-42, wherein by allocating the a different size, the pattern is then adjusted within the spatial extent or zone to be able to be properly formatted on the page).

Regarding Claim 35, Silverbrook teaches a computer program Column 1, line 5-13, wherein a program must be run in order for the apparatuses to function properly) which is arranged to:

receive a first document for printing, the first document comprising at least one functional area in which pattern markings are to be printed (Column 2, lines 3-5 and Column 4, line 66 - Column 5, line 6, wherein the document is prepared to be printed with the content and the coded data),

generate from the first document a second document in which at least one of the shape and or size and or location of the at least one functional area is modified (Figure 25, elements 836, 834 and Column 12, lines 10-42, wherein the first document is the original document and the second document is the formatted document. The formatted document is adjusted from the original document to print the document as desired by the user in regards to the user's preferences, i.e. size.), and

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request a portion of pattern to fit the modified functional area from a source of pattern, the program allocating pattern to the functional area according to its shape and or location and or size after modification (Column 14, lines 15-17).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 18-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (US 6,987,573) in view of Natori (US 2002/0175958).

Regarding Claim 18, Silverbrook does not teach in which the step of modifying the document and/or obtaining the pattern for the functional area is performed by a print application such as a printer driver.

Natori does teach in which the step of modifying the document and/or obtaining the pattern for the functional area is performed by a print application such as a printer driver (Page 2, paragraph 20 and Page 5, paragraph 61).

Silverbrook and Natori are combinable because they both deal with a applying a pattern to a document for printing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Silverbrook with the teachings of Natori for the purpose of allowing the user to have control over modifying the document to their own preference (Natori: Page 5, paragraph 61).

Regarding Claim 19, Silverbrook does not teach in which the printer driver presents to a user one or more prompts for the user to modify the first document.

Natori does teach in which the printer driver presents to a user one or more prompts for the user to modify the first document (Page 2, paragraph 20 and Page 5, paragraph 61).

Silverbrook and Natori are combinable because they both deal with applying a pattern to a document for printing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Silverbrook with the teachings of Natori for the purpose of allowing the user to have control over modifying the document to their own preference (Natori: Page 5, paragraph 61).

Regarding Claim 20, Silverbrook does not teach in which the step of modifying the document and/or obtaining the pattern for the functional area is performed by a print application such as a printer driver.

Natori does teach in which the step of modifying the document and/or obtaining the pattern for the functional area is performed by a print application such as a printer driver (Page 2, paragraph 20 and Page 5, paragraph 61).

Silverbrook and Natori are combinable because they both deal with a applying a pattern to a document for printing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Silverbrook with the teachings of Natori for the purpose of allowing the user to have control over modifying the document to their own preference (Natori: Page 5, paragraph 61).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas C. Pachol whose telephone number is 571-270-3433. The examiner can normally be reached on M-Thr, 8:00 a.m.- 4:00 p.m. (EST), Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. C. P./  
Examiner, Art Unit 2625

08/20/09

/Twyler L. Haskins/  
Supervisory Patent Examiner, Art Unit 2625